Claim 8, line 9, cancel "the" and replace with --a--.

REMARKS

Reconsideration of the various objections and rejections set forth in the Office Action dated September 1, 1999 is respectfully requested in view of the foregoing amendment and following remarks.

The Examiner objected to the drawings under 37 C.F.R. §1.83(a), stating "The drawings must show every feature of the invention specified in the claims. Therefore, the "Rain Test" must be shown for 120 minutes not just for 90 minutes or the feature(s) canceled from the claim(s)." The Examiner's objection skips over the threshold question of whether the referenced drawing (never identified and assumed by the Applicants to be Figure 3) is even required by the claims. Naturally, the drawing must be required before an objection can be raised as to content. 37 C.F.R. §1.81(a) states, "The applicant for a patent is required to furnish a drawing of his or her invention **where necessary for the understanding of the subject matter sought to be patented** ...". The Examiner's attention is respectfully directed to Fig. 3 which is a graph, for footballs made of different materials, having axes of time and percent weight increase over original dry weight. Nowhere in Fig. 3 is there a disclosure of the actual weight of the water absorbed versus time. The Examiner is next respectfully directed to claims 8, 9 and 10, the only claims involving a "Rain Test" with a cycle time of up to 120 minutes. As clearly stated in those claims, the water absorption is

in terms of grams absorbed and not percent weight increase over original dry weight. Thus, Fig. 3 while it provides additional information and disclosure, is not necessary for the understanding of Applicants' invention as embodied in claims 8, 9 and 10. It should be noted that all of the claims, and especially claims 8, 9 and 10, are supported by Applicants' specification, including the tables. Finally, as the Examiner will appreciate, a weight measurement is seldom, if ever, found in the drawings, but rather is included in the text of substantially all patents. Accordingly, it is submitted that the drawings are in compliance with the provisions of 37 C.F.R. §1.83(a), and withdrawal of the objection is earnestly solicited.

The Examiner objected to the disclosure under 37 C.F.R. §1.71 "as being so incomprehensible as to preclude a reasonable search of the prior art by the Examiner". The Examiner goes on to state "Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art". Interestingly, in the same Office Action following the above statements, the Examiner cites prior art (presumably from a search) and rejects Applicants' invention as embodied in the pending claims over that prior art. Thus, either the Examiner's actions contradict the Examiner's own statements and the Examiner was able to make a proper comparison of the invention with the prior art, in which case this objection is improper and should be withdrawn; or the Examiner has not made a proper comparison of the prior art and Applicants' invention, in which case the claim rejection is improper and should be withdrawn.

The Examiner admits to not understanding Applicants invention, stating "For example, the following items are not understood: "Rain Test" has never before been used in this art." Since an invention to be patentable must be novel, see for instance, 35 U.S.C. §101, it is not surprising that the Examiner is occasionally exposed to something that has never before been used in the art. The patent laws were written to encourage people to disclose new inventions to the public, and therefore this should not be used as a basis for objection. With regard to disclosure of the "Rain Test", the Examiner's attention is directed to Applicants' specification at page 12, line 18 to page 13, line 27 which discloses the "Rain Test" apparatus and procedure.

The Examiner also objected to the disclosure because of a number of other listed informalities. On page 13, line 18, the Examiner stated "was" should be --were--. The complete sentence reads, "Each of the balls <u>was</u> subjected ...". Thus, "was" refers not to the prepositional phrase "of the balls", but instead to the singular "each" and the sentence is therefore correct as written. The Examiner stated on page 18, "Comparative Example 3" should be --Comparative Example 2--. The Examiner is correct and the disclosure has been amended to reflect this change. The Examiner questioned page 14, Table 1A, asking "for 0 time, where do the negative numbers come from?". As described on page 13, line 11 to line 27, each ball is weighed to determine its starting weight and the weights recorded. The balls are subjected to the "Rain Test" and at scheduled time intervals the balls are removed, excess water wiped off the surface and the ball weighed. The balls are then subjected to further testing.

As stated on page 13, line 19, "at the end of the testing cycle, i.e., up to 120 minutes of testing time, the ball was removed from the chamber and allowed to dry for about 24 hours at about 70°F. At the start of the next test cycle, the ball was weighed again, and the weight noted. In the Tables 1(A), 2(A) . . . the increase in weight of the ball for each recording is given in grams." Thus, when the Tables are interpreted in light of Applicants' disclosure, it is clearly seen that the negative numbers at the zero time, simply mean the test ball at the start of that cycle weighed less than it did at the start of cycle 1.

The Examiner questioned what the original weight of each ball in the Examples 1 - 5 was. While the weight of game balls in general, and American footballs in particular, is regulated by various organizations such as the NFL and NCAA, there is a range of weights which are allowable. Thus, each individual ball in a given model will vary within that range; and balls of different models, which may be subject to different regulations, will vary even more widely. Thus, comparison of the individual weight of test subjects is not only irrelevant, but can be misleading. The amount of water absorbed is a better criterion for comparing game balls and even more preferable is Applicants' weight ratio, which can be used to compare game balls across different manufacturers and models. Thus, the starting weight of the game balls is not necessary to either understand or practice Applicants' invention.

The Examiner questioned, "How were 'the ratio' derived?". The Examiner's attention is respectfully directed to the text starting on page 10, line 23 of Applicants'

specification, which states, "If a game ball of the present invention having a leather cover and lining is subjected to the "Rain Test" (as described herein) for a period of 45 minutes, the ball would absorb a limited amount of water expressed as the 'absorption ratio' of the weight of the ball plus absorbed water to the dry weight of the ball . . ." In other words, the absorption ratio equals the sum of the dry weight of the ball plus absorbed water divided by dry weight of the ball. Applicants submit that the specification, as amended, is in condition to overcome the Examiner's objection.

Claims 1 through 10 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. More particularly, the recitation in claim 1 of "the rain test" and in line 4, "ratio" bridging lines 5 to 6 was asserted to have insufficient antecedent basis. Applicants have amended claim 1 so that this claim is now definite and overcomes this rejection. Similarly, Claim 8 was rejected for citing the limitation "the tanning process of said leather" in line 6. Claim 8 has also been amended so that it is now definite and overcomes this rejection. Claim 3 was rejected for the feature therein of "the ratios in the range of 1.01:1 to 1.2:1" allegedly being unnecessarily duplicative. Claim 1 recites a specified game ball which when subjected to a specified test cycle, has a specified water absorption ratio. Claim 3 which depends from claim 1, recites the same specified ball as claim 1 and a different specified test cycle. The recited text must be viewed in light of the different specified test cycle of claim 3 and therefore is not unnecessarily duplicative. Indeed, deletion of the text quoted by the Examiner may make claim 3 indefinite. Since claim 3 as written is definite, Applicants

traverse this rejection.

Claims 1 through 8 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,069,935 to Walters as applied to the above claims and further in view of British Patent 1,021,424 to Osborne and U.S. Patent 5,820,488 to Sullivan et al. Walters teaches the surface coating of leather with a polyfluoroalykylpolymer resin dissolved in 1,1,1, trichloroethane. As disclosed in Walters, column 7, lines 15 through 24, the surface coating **must be done in different stages of the footballs construction.** As taught by Walters, the inside surface of the leather must be coated before assembly of the ball and the outside surface of the ball coated after assembly of the ball. This is clearly different from Applicants' invention in which the leather is tanned so that the moisture resistance permeates the extent of the leather. As discussed by Applicants' disclosure, for instance, page 10, lines 17 through 21, and as supported by the test results. Therein, Applicants' invention which incorporates leather having a permanent tanned-in water resistance is superior to surface coatings such as that taught by Walters. Further, Applicants' invention allows water vapor to pass through rather freely. It is doubtful that the surface coating material of Walters, especially when applied to both the inside and outside surfaces as taught by the disclosure of Walters, can allow water vapor to penetrate. Further still, nowhere in Walters is there a disclosure of a test similar to Applicants' "Rain Test". In fact, Walters at column 5, lines 5 through 11 teaches that the coating of Waters gives erratic results when exposed to rain test conditions. For at least the

above reasons, the reference of Walters does not teach or suggest Applicants' invention.

The Examiner cites the references of Osborne and Sullivan et al against claims 1 through 8. The Examiner does not discuss those references nor disclose how those references are related to either Applicants' invention or the reference of Walters. Perhaps this is due to the fact that both of the references of Sullivan and Osborne teach the moisture proofing of a golf ball core and neither reference teaches or suggests moisture proofing of leather or leather game ball covers. Thus, the references of Sullivan and Osborne do not teach features of Applicants' invention and are not properly combined with the reference of Walters. Since the features of Applicants' invention, as embodied in claims 1 through 8, are not taught or suggested by the Examiner cited references, those claims are patentable for at least these reasons.

Claims 1 through 10 were provisionally rejected under judicially created doctrine of obviousness type double patenting as being unpatentable over claims 1 through 8 of co-pending application number 09/184,369. Applicants respectfully disagree with the provisional double patenting rejection based on application number 09/184,369. Nevertheless, in order to expedite issuance of this application and without acquiescing in the double patenting rejection, Applicants submit herewith a Terminal Disclaimer signed by the Attorney of Record for the common Assignee of this application and application number 09/184,369.

In summary, Applicants have addressed each of the objections and rejections within the Office Action, either by amendment or remarks. The disclosure is comprehensible, the claims are definite and the prior art has been found to be woefully lacking in either anticipatory or suggestive value. It is believed the application now stands in condition for allowance, and prompt favorable action thereon is earnestly solicited.

Respectfully submitted,

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